

REMARKS

Claims 1-44 are pending. Claim 41 as amended to cure a typographical error.

Claims 1-11, 17-31, 37-44 are rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art ("APA") in view of JP 2001 060838 to Takazawa et al. ("Takazawa").

Claims 12-16 and 32-36 are rejected under 35 U.S.C. § 103 as being unpatentable over APA in view of Takazawa and further in view of U.S. Patent 4,677,518 to Hershfield ("Hershfield"). Reconsideration of the application in light of the remarks below is respectfully requested.

An analysis applying 35 U.S.C. §103 requires determining the scope and content of the prior art and the differences between the prior art and the claims at issue. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). If all the elements in a claimed invention are found in a combination of prior art teachings, a claimed invention may be found obvious in light of the prior art only if there is "an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *Id.* at 1741.

Here, there are elements in independent claims 1, 21, 41 and 43 that are not shown even in a combination of the cited prior art. See, e.g., M.P.E.P. §706.02(j) (requiring that the cited prior art in combination must show all of the claimed limitations in order to establish a prima facie case of obviousness).

Among the limitations of independent claim 1, which are neither disclosed nor suggested even in a combination of the art of record are:

a transient voltage suppression component electrically coupled to said contacts and said terminals including: a transient voltage suppression device having a capacitance and a frequency compensation device, wherein said frequency compensation device is effective to neutralize said capacitance of said transient voltage suppression device.

Similarly, among the limitations of independent claim 21, which are neither disclosed nor suggested even in a combination of the art of record are:

said transient voltage suppression component comprising: a transient voltage suppression device having a capacitance and a frequency compensation device, wherein said frequency compensation device is effective to neutralize said capacitance of said transient voltage suppression device.

Among the limitations of independent claim 41, which are neither disclosed nor suggested even in a combination of the art of record are:

said transient voltage suppression component including: a transient voltage suppression device having a capacitance and a frequency compensation device, wherein said frequency compensation device is effective to neutralize said capacitance of said transient voltage suppression device.

Among the limitations of independent claim 43, which are neither disclosed nor suggested even in a combination of the art of record are:

shunting a transient voltage introduced to the circuit using a transient voltage suppression device; and frequency compensating for the shift in frequency caused by the capacitance of the transient voltage suppression device.

The Office Action agrees that APA does not show the above referenced frequency compensation device or frequency compensating act and points to Takazawa as showing these limitations. The Takazawa reference is cited to show that an inductor may be used as a frequency compensation device. Office Action, page 2. However, there is no discussion in either Takazawa or APA of specifically placing an inductor in a defined circuit with a particular inductance so as to neutralize a capacitance of a transient voltage suppression device as claimed in claims 1, 21 and 41. Similarly, there is no discussion in Takazawa or APA for frequency compensating for a shift in frequency caused by a capacitance in a transient voltage suppression

device - as recited in claim 43. In fact, there is no indication that the inductor in Takazawa has any relation to any capacitance, certainly not the capacitance referenced in claims 1, 21, 41 and 43. Takazawa simply shows an inductor in parallel with a varistor. Even if the varistor could operate as a transient voltage suppression device, there is no indication that the inductor is chosen to neutralize capacitance in that varistor.

Moreover, there is no apparent reason to combine Takazawa and APA in the fashion claimed - as is required in an obviousness analysis. The Office Action states that the reason to combine the prior art is "to alleviate the effects of the capacitance of the TVS device and to have transient suppression with a little distortion in the waveform of a high frequency signal" and points to the Takazawa abstract as supporting this assertion. Office Action, page 3. However, the Takazawa reference is designed to produce a circuit "with a sufficient static electricity suppressing effect with a little distortion in the waveform of a high frequency signal. . . ." Takazawa abstract. There is no discussion in Takazawa of alleviating the effect of capacitance in a TVS device as suggested by the Office Action. Thus, contrary to the assertion in the Office Action, there is no apparent reason to combine elements alleged to be in the prior art in the fashion claimed.

Therefore, it is asserted that independent claims 1, 21, 41, and 43 are patentable over even a combination of APA and Takazawa.

The reference to Hershfield is not cited to show, and does not appear to show, the above-referenced limitations. As such, it is asserted that independent claims 1, 21, 41 and 43 are patentable over even a combination of APA, Takazawa and Hershfield. Dependent claims 2-20, 22-40 and 44 include the above-referenced limitations for independent claims 1, 21 and 43 respectively, and include additional limitations which, when combined with limitations of independent claims 1, 21 and 43 are also neither shown nor suggested even in a combination of in the art of record. It is asserted that these claims are patentable as well. Reconsideration of the rejection of claims 1-44 under 35 U.S.C. § 103 is respectfully requested in light of the remarks above.

The director is hereby authorized to charge any deficiency or credit or any overpayment to Deposit Account No. 23-2820.

Respectfully submitted,



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